APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,735	07/02/2001	David Guedalia	4529/83200	8182

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EXAMINER
CASIANO, ANGEL L

ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _14 January 2005_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
  closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,2,8,11,12,19 and 21-34_ is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,2,8,11,12,19 and 21-32_ is/are rejected.

7)☒ Claim(s) _33 and 34_ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All   b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

FRITZ FLEMING
PRIMARY EXAMINER
GROUP 2100

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
  Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Response to Amendment

The present Office action is in response to Amendment dated 14 January 2005.

Claims 1-2, 8, 11-12, 19, and 21-34 are pending. All claims have been examined.

Specification

1. Previous Objection to the Specification has been overcome with the submission of the present Amendment.

Claim Rejections - 35 USC § 112

2. Previous Rejections under 35 U.S.C. 112, second paragraph has been overcome with the present Amendment.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 11-12, 21-22, 25, and 28-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Mendiola et al. [US 2002/0006803 A1].

Regarding claim 1, Mendiola et al. teaches a method for instant messaging (see "Title", "Abstract") enabling a thin client (see "mobile phone"; Page 1, [0001-0002]) to employ a server (see "server"; Page 2, [0028-0035]) for initiating a communication channel between at least first and second instant messaging users (see Page 2, [0019]); and conducting instant messaging along said communication channel between said instant messaging users (see Page 2, [0028, 0029]). Mendiola et al. teaches enabling non-persistent clients (see "mobile phones", Page 1, [0001-0002]) to maintain a session along the communication channel (see Page 2, [0031]; Page 7, [0124]). In [0031], the reference teaches the registration means as keeping track of user presence. Mendiola et al. teaches directing a client to a previously opened session at a server (see Page 3, [0048], "prospective user invited to register by an existing user"; Page 7, [0124]). This is using a previously existing session with a user to establish a new session, "*via the existing user*".

As for claim 2, Mendiola et al. teaches a server for simplifying client-side connection negotiations to initiate the communication channel (see Abstract; Page 2, [0019], "quickly and efficiently"). The reference also teaches a "thin client device" (see "mobile phone").

Regarding claim 11, Mendiola et al. teaches a system for instant messaging (see "Title", "Abstract"; Figures 1-5) enabling a thin client (see "mobile phone"; Page 1, [0001-0002]) to employ a server (see "server"; Page 2, [0028-0035]) for initiating a communication channel between at least first and second instant messaging users (see Page 2, [0019]); and conducting instant messaging along said communication channel between said instant messaging users (see Page 2, [0028, 0029]). The prior art also specifies a server (see Figure 3, "89") having

a "registration handler", (element "96"). Mendiola et al. also teaches a system for enabling non-persistent clients (see "mobile phones", Page 1, [0001-0002]) to maintain a session along the communication channel (see Page 2, [0031]; Page 7, [0124]). Mendiola et al. teaches communication protocol for communication between the server and first and second communication devices (see "GSM", "SMS", Page 1, [0013-0014]). Mendiola et al. teaches a system implementing the step of directing a client to a previously opened session at a server (see Page 3, [0048], "prospective user invited to register by an existing user"; Page 7, [0124]).

As for claim 12, Mendiola et al. teaches a system for simplifying client-side connection negotiations to initiate the communication channel (see Abstract; Page 2, [0019], "quickly and efficiently").

As for claim 21, Mendiola et al. teaches users using Global System for Mobile communication ("GSM") networks (see page 1, [0002]). The reference does not mention a WAP client. However, WAP supports GSM and HTML.

As for claim 22, Mendiola et al. teaches a server having session information (see Figure 3, "89", "96"; Page 2, [0031]).

As for claim 25, Mendiola et al. teaches account information for validating user access (see Page 2, [0033-35]).

As for claim 28, Mendiola et al. teaches users using Global System for Mobile communication ("GSM") networks (see page 1, [0002]). The reference does not mention a WAP client. However, WAP supports GSM and HTML. In addition, the prior art shows a GSM server in communication with the IM server (see Figure 1, "15", "19").

As for claim 29, Mendiola et al. teaches and external server for communication between an IM service and server (see Figure 4).

Regarding claim 30, Mendiola et al. teaches a method for instant messaging (see "Title", "Abstract") enabling a thin client user (see "mobile phone"; Page 1, [0001-0002]) to employ a server (see "server"; Page 2, [0028-0035]) for initiating a communication channel between at least first and second instant messaging users (see Page 2, [0019]); and conducting *text-based* (see [0058]) instant messaging along said communication channel between said instant messaging users (see Page 2, [0028, 0029]). In [0031], the reference teaches the registration means as keeping track of user presence. Mendiola et al. also teaches directing a client to a previously opened session at a server (see Page 3, [0048], "prospective user invited to register by an existing user"; Page 7, [0124]). This is using a previously existing session with a user to establish a new session, *"via the existing user"*, for a user that is not part of the IM community.

As for claim 31, Mendiola et al. teaches that a "prospective user" is " invited to register by an existing user"; Page 7, [0124]). That is, a user who was disconnected (because

was not a member of the IM community) uses a previously existing active session with a user to

establish a new session, *via the existing one*.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a whole
> would have been obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains. Patentability shall not be negatived
> by the manner in which the invention was made.

6. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mendiola et

al. [US 2002/0006803 A1] in view of Ramasubramani et al. [US 6,507,589 B1].

As for claim 8, Mendiola et al. teaches clients having IM applications of different

types (see Page 2, [0019]; Page 3, [0042]). However, the cited art does not explicitly teach a

"first communication protocol" between first user and presence server or a "second

communication protocol", which is "different from said first communication protocol" between

server and second instant messaging user. Ramasubramani et al. teaches "various mobile

device" of "different type". Nonetheless, Ramasubramani et al. does teach communication with

a server using *different protocols* (see Abstract; column 1, line 35; column 2, lines 63-67).

Accordingly, at the time of the invention one of ordinary skill in the art would have been

motivated to combine the cited disclosures in order to obtain a method capable of routing

messages, from mobile devices using different protocols, as taught by Ramasubramani et al.

As for claim 19, Mendiola et al. teaches a system in which clients have IM applications of different types (see Page 2, [0019]; Page 3, [0042]). However, the cited system does not explicitly teach a "first communication protocol" as being different from a "second communication protocol". Regarding this limitation, Ramasubramani et al. teaches "various mobile device" of "different type". In addition, Ramasubramani et al. does teach communication with a server using different protocols (see Abstract; column 1, line 35; column 2, lines 63-67). Accordingly, at the time of the invention one of ordinary skill in the art would have been motivated to combine the cited disclosures for the reasons stated in the Rejection of claim 8.

7. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mendiola et al. [US 2002/0006803 A1] in view of Ball et al. [US 2002/0126135 A1].

As for claim 23, Mendiola et al. does not explicitly teach an "audio file server" associated with a "presence server". Regarding this limitation, Ball et al. (see [0243] and [0250]) teaches a server for audio files. Accordingly, one of ordinary skill in the art at the time of the invention would have been motivated to combine the cited disclosures in order to transmit audio files from a network server to a mobile client "efficiently" and "accurately" (see Ball et al.).

8. Claims 24, 26-27, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mendiola et al. [US 2002/0006803 A1] in view of Philonenko [US 20020131399 A1].

As for claims 24 and 26, Mendiola et al. does not teach an *IVR* operative to interface between a telephone and a presence server. Regarding this limitation, Philonenko teaches applying an IVR for instant messaging communication events (se Page 2, [0023], [0029]). Accordingly, one of ordinary skill in the art would have been motivated to combine the cited disclosures in order to implement a communication events processing method, as taught by Philonenko. The combination of references would have provided communication (IM) routing.

As for claim 27, Mendiola et al. teaches a message cache (see Page 1, [0013]).

As for claim 32, Mendiola et al. does not teach an *IVR* system. Regarding this limitation, Philonenko teaches applying an IVR for instant messaging communication events (se Page 2, [0023], [0029]). Accordingly, one of ordinary skill in the art would have been motivated to combine the cited disclosures in order to implement a communication events processing method, as taught by Philonenko. The combination of references would have provided communication (IM messages) routing.

Allowable Subject Matter

9. Claims 33-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10.   Regarding claim 1, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Page 9 of the Remarks; "setup and use a communication channel and thereafter disconnect itself from the presence server"; emphasis added) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11.   Regarding independent claim 11 and dependent claim 23 (Page 12 of the Remarks), in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

12.   As for dependent claim 24 (Page 13 of the Remarks), in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).   In this case, even if Applicant argues that Philonenko discloses a different use for an IVR system, the combination of references must be taken for its suggestions as a whole.

Conclusion

13.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Angel L. Casiano whose telephone number is 571-272-4142. The

examiner can normally be reached on 9:00-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FRITZ FLEMING
PRIMARY EXAMINER
GROUP 2100

Alc
25 May 2005